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16D

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/591,447    04/18/96    QUENTIN-MILLET    M    XI/P02956US0

000881    HM22/0928  
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EXAMINER

PAK, M

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

09/28/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/591,447**

Applicant(s)  
**Quentin-Millet et al.**

Examiner  
**Michael Pak**

Group Art Unit  
**1646**



☒ Responsive to communication(s) filed on Jul 6, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 54-78 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 54-78 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed 6 July 1999, Paper No. 28, has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicant's arguments filed 6 July 1999, Paper No. 28, have been fully considered but they are not found persuasive.

***Claim Rejections - 35 USC § 112***

4. Claims 54-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly amended claims 54-78 are indefinite and confusing because of the recitation of "maximal amino acid alignment versus the total number of positions while introducing vacant positions artificially" as discussed in the previous office actions. The discussion concerning "homology" was set forth in the office action filed 5-14-97 (Paper No. 14) and the actions thereafter are continuing discussions of the arguments and amendments presented

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by the applicants.

Applicants argue that maximal alignment results in only one answer from the hypothetical alignment provided by the Examiner. This is not true since all the sequences have gaps although not drawn in the example provided by the examiner and it is not clear which is the maximal alignment. The metes and bounds can only be ascertained with specifically set forth parameters and not the generic term "maximal" which describes the results.

Applicants further argue that specification is in compliance with the specified requirements of reference of George et al., because the present claims and specification provide for a scoring rule as it is taught that the alignment shall be maximal. However, the term "maximal" is not the scoring rule but rather it is the result desired. There are many possible results for the desired maximal alignment for which the metes and bounds are not clear but only a specific set of parameters will provide a specific result.

#### ***Claim Rejections - 35 USC § 102***

5. Claims 54-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Legrain et al. (AS) for the reasons set forth in the last office action and discussed below.

Applicants argue that claims amendments to delete the term "identity" results in claims which are clearly defined to exclude

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the receptors of the prior art which are not obtained by total or partial deletion as is the case in the present claims. However, the claims are directed comprising language due to the term "having" and since the metes and bounds of the term "maximal amino acid alignment versus the total number of positions while introducing vacant positions artificially" is not clear the receptor and the fragments thereof of the Legrain et al. reference anticipates the claims. As discussed in the last office action, SEQ ID NO: 2 and 4 are identical to the TBP2 amino acid sequences of Legrain et al. (see attached sequence comparisons submitted in the previous office actions).

6. Claims 54-76 and 78 remains rejected under 35 U.S.C. 102(b) as being anticipated by Quentin-Millet et al. (AM) for the reasons set forth in the last office action.

Applicants arguments were grouped together in discussing the LeGrain et al. rejection above. The discussion set forth above addresses the same arguments for the Quentin-Millet et al. rejections.

7. No claims are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242.  
Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*MDP*  
Michael D. Pak  
Patent Examiner  
Art Unit 1646  
22 September 19989

  
**PAULA K. HUTZELL**  
**SUPERVISORY PATENT EXAMINER**